



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/581,663

06/05/2006

Kazuhito Ikeda

Q95272

4563

23373 7590 08/05/2010
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

JAVANMARD, SAHAR

ART UNIT

PAPER NUMBER

1627

NOTIFICATION DATE

DELIVERY MODE

08/05/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

sughrue@sughrue.com
PPROCESSING@SUGHRUE.COM
USPTO@SUGHRUE.COM

DETAILED ACTION

Status of the Application

This Office Action is in response to applicant's arguments filed on May 10, 2010. Claim(s) 1 and 8-12 are pending. Claim(s) 1 has been amended. Claim(s) 11 and 12 are newly added. Newly submitted claims 11 and 12 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11 and 12 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Claim(s) 1 and 8-10 are examined herein.

Response to Arguments

Applicant's arguments with respect to the 112-1st rejection of claims 1, 2, 5, 6, and 8-10 have been fully considered but are not persuasive. Applicant has not demonstrated that ischemic nerve injury may be absolutely or permanently prevented therefore said rejection is hereby maintained.

Applicant's argument and amendment with respect to the 102(b) rejection of claims 1, 2, 5, 6, and 8-10 as being anticipated by Kimura et al. (WO 02/09756) of record (the English equivalent US Patent 7,244,761 B2 is employed) have been fully considered but are not persuasive. As set forth on record previously, no patentable

Art Unit: 1627

weight is given for the “intended use” of the pharmaceutical composition containing formula 1 (or newly amended 22) as recited in claims 1, 2, 5, 6, and 8-10. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Additionally, with respect to newly added method claims 11 and 12, reasons for being withdrawn from consideration are given above. As a result, the instant rejection is hereby maintained.

The rejections of record from the previous Office action are maintained/modified as necessitated by amendment and are set forth on record in the Final Office action below for Applicant's convenience.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 8-10 are rejected under 35 U.S.C. 112, first paragraph, for scope of enablement because the specification, while being enabling for the treatment of

Art Unit: 1627

ischemic nerve injury, does not reasonably provide enablement for the prevention of ischemic nerve injury as recited in these claims.

The instant claims are drawn to a preventive agent for ischemic nerve injury. The instant specification fails to provide information that would allow the skilled artisan to practice the instant invention. Attention is directed to *In re Wands*, 8 USPQ2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factors to consider when assessing if a disclosure would have required undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546 (BdApls 1986) at 547 the court recited eight factors:

(1) the nature of the invention; (2) the state of the prior art; (3) the relative skill of those in the art; (4) the predictability or unpredictability of the art; (5) the breadth of the claims; (6) the amount of direction or guidance presented; (7) the presence or absence of working examples; and (8) the quantity of experimentation necessary.

Nature of the invention:

The instant invention pertains to a preventive agent for ischemic nerve injury.

The state of the prior art:

The skilled artisan would view that the prevention of one or more symptoms of ischemic nerve injury totally, absolutely, or permanently, is highly unlikely, since one cannot guarantee that the ischemic nerve injury will always be prevented.

The relative skill of those in the art:

The relative skill of those in the art is very high.

The predictability or lack thereof in the art:

The skilled artisan would view that the treatment to prevent ischemic nerve injury, absolutely, or permanently is highly unpredictable.

The amount of direction or guidance presented and the presence or absence of working examples:

In the instant case, no working examples are presented in the specification as filed showing how to prevent ischemic nerve injury totally, absolutely, or permanently. Note that lack of a working example, is a critical factor to be considered, especially in a case involving an unpredictable and undeveloped art. See MPEP 2164.

Genentech, Inc. v. Novo Nordisk, 108 F.3d at 1366, states that "a patent is not a hunting license. It is not a reward for search, but compensation for its successful conclusion" and "[p]atent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable".

Therefore, in view of the *Wands* factors, e.g., the amount of direction or guidance provided, absence of working examples, and the predictability of the art discussed above, to practice the claimed invention herein, a person of skill in the art would have to engage in undue experimentation to test the combination in the instant claims whether preventing ischemic nerve injury totally, absolutely, or permanently.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

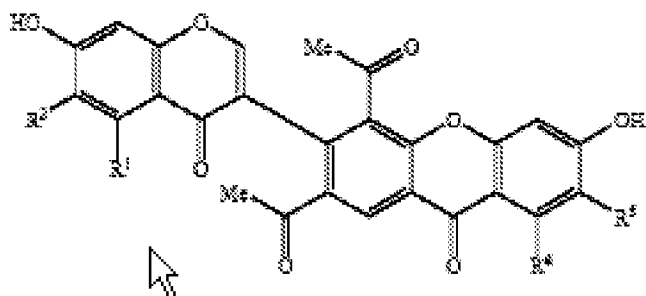
Claims 1 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Kimura et al. (WO 02/09756) of record (the English equivalent US Patent 7,244,761 B2 is employed).

Examiner respectfully notes that no patentable weight is given for the “intended use” of the pharmaceutical composition containing formula 1 as recited in claims 1, 2, 5, 6, and 8-10. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Kimura teaches low-molecular weight compound, which acts to inhibit the growth cone collapse activity of semaphoring such as semaphorin 3A, semaphorin 6C or the like and/or the nerve outgrowth inhibitory activity of semaphorin in a collagen gel and which does not substantially affect cell proliferation, is obtained from the culture of

Art Unit: 1627

strain SPF-3059 belonging to the genus Penicillin. The low-molecular weight compound with the semaphorin inhibitory activity thus obtained exhibits the in vivo nerve-regeneration promoting action (abstract).



Specifically chemical formula 27 above is taught, wherein at least one of R² and R⁵ represents a hydroxyl group, a pharmaceutically acceptable salt thereof or a derivative thereof; the compound according to the above wherein R² represents a hydroxyl group, a pharmaceutically acceptable salt thereof or a derivative thereof; the compound according to the above wherein R² and R⁵ represent a hydroxyl group, a pharmaceutically acceptable salt thereof or a derivative thereof; the compound according to any of the above wherein R⁴ represents a carboxyl group, a pharmaceutically acceptable salt thereof or a derivative thereof; and the compound according to the above wherein R¹ and R⁴ represent a carboxyl group and R² represents a hydroxyl group, a pharmaceutically acceptable salt thereof or a derivative thereof (column 11, lines 13-66), meeting the limitations of the instant claims.

Conclusion

Claims 1 and 8-10 are not allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 1627

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAHAR JAVANMARD whose telephone number is (571) 270-3280. The examiner can normally be reached on 8 AM-5 PM MON-FRI (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/S. J./

Examiner, Art Unit 1627

/SREENI PADMANABHAN/

Supervisory Patent Examiner, Art Unit 1627